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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,024	06/26/2001	Guolin Cai	00-432-A	1826

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EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,024

Applicant(s)

CAI ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 9, 11, 15, 16, 18, 19, 27-28, 33, 5362-66, 83-87 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 83-87 is/are allowed.
- 6) ☒ Claim(s) 1, 9, 11, 15, 16, 18, 19, 27-28, 33, 53, 62-66 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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Detailed Action

The 112, second paragraph rejection of claim 1, the 112, first paragraph rejection of claims 1, 9, 11-12, 15-16, 18-19, 27-28, 33, 61 at paper no. 13 is withdrawn in light of applicant's amendment filed 11/25/03.

(modified rejection)

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim(s) 62-66 in part are rejected under 35 U.S.C. 112, first paragraph. These demonstrations do not define utility. Since this is an assay method, it is recommended that such methods be specifically described in the claims and the positive identification of GABA_A receptor in cell or tissue when the sample is greater than the control comprising steps measuring the procedure. The applicant is referred to *In re Fouché* 169 USPQ 429 ccpa, 1971, MPEP 716.02 B. The applicant is referred to *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in *Ex parte Foreman* 230 USPQ 546 (Bd. Of App. And Inter 1986).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is

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“undue”. These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art 6) the amount of direction provided by the inventor 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In *re Wands*, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

In terms of factor 3 and 5, the state of the art and the level of predictability in the art cannot be predicted with any certainty beyond what specific test compounds /compositions and/or additional therapeutic agents should be used and are likely to provide productive results beyond those therapeutic compounds/compositions and/or additional therapeutic agents taught in the specification.

In terms of factors 4 and 6, the inventor provides no guidance beyond the therapeutic compound/compositions and/or therapeutic agents as taught in the specification as previously mentioned. As a result one of ordinary skill in the art could not predict what other types of therapeutic compounds/compositions and/or additional therapeutic agents, other than those taught in the specification; and with regards to the 7th and 8th Wands factor, while the existence of working examples are limited to the aforementioned compounds/compositions as taught in the specification, an indeterminate quantity of experimentation would be necessary to determine all potential therapeutic compounds/compositions' effects on signal-transducing activity of GABA_A receptors .

In terms of the 8th Wands factors, undue experimentation would be

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required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of predictability in the art of the invention, and the poor amount of direction provided by the inventor. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

(new rejection)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 62-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 62, line 6, page 9 of the amendment filed 11/25/03 and all other occurrences throughout the claims 63-66, the term "RO15-1788" is indefinite since trade names can not be claimed unless they are well known in the art.

B. In claim 62, line 4, page 9 of the amendment filed 11/25/03 and all other occurrences throughout claims 63-66, the phrase "plurality of matched cell or tissue samples", is indefinite. It is not clear which match cell or tissue samples are being claimed.

C. In claim 62, line 17 , page 9 of the amendment filed 11/25/03 and all other occurrences throughout the claims 63-66, the phrase "under conditions that permit

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binding of RO15-1788 to GABA_A" is indefinite because these conditions are not specified.

D. In claim 62-66, the method for demonstrating the presence of GABA_A receptors in cell or tissue samples is indefinite. Since this is an assay method, it is recommended that such methods be specifically described in the claims and the positive identification of GABA_A receptor in cell or tissue when the sample is greater than the control comprising steps ^{of the} measuring ~~the~~ procedure.

Claims 1, 9, 11, 15, 16, 18, 19, 27-28, 33, 53, 83-87 are allowable.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson

February 23, 2004


CEILA CHANG
PRIMARY EXAMINER, Acting SPE
GROUP 1200 1625